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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,953	04/30/2001	Terry Wayne Liles	16356.605 (DC-02889)	3329
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HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER YIGDALL, MICHAEL J	
			ART UNIT 2192	PAPER NUMBER

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/845,953

Applicant(s)

LILES ET AL.

Examiner

Michael J. Yigdall

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-12, 14-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2005 has been entered. Claims 1-3, 5-12, 14-21 and 23-28 are pending.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant contends that the combination of Fontanesi and van Gilluwe does not teach configuring a memory to store a control process; in response to a size of a storage device, identifying a sector offset on the storage device; determining the sector offset by the control process prior to an operating system being installed on the computer system; storing an image onto the storage device at the sector offset by copying the image from the memory to the storage device; proving the sector offset to an installation engine; and subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image (Applicant's remarks, page 12).

However, the combination of Fontanesi and van Gilluwe does teach the above limitations, as set forth in the claim rejections below. Furthermore, Applicant's arguments do not specifically point out how the language of the claims patentably distinguishes from or excludes the references.

Applicant alleges generally that there is no basis in the art for combining the references, that neither patent teaches or even suggests the desirability of the combination, and that the combination arises solely from hindsight without any showing of suggestion, incentive or motivation in either reference (Applicant's remarks, page 14).

However, Applicant's allegations were expressly addressed in the previous Office action. To reiterate, Fontanesi and van Gilluwe are both directed toward the installation of an operating system. Fontanesi teaches storing an image that includes an operating system on a storage device. The location at which to store the image must be identified. Van Gilluwe provides a means to identify that location based on the characteristics of the storage device. One of ordinary skill in the art would have been motivated to supplement Fontanesi with the teachings of van Gilluwe so that the location at which to store the image can be identified based on the characteristics of the storage device. Moreover, the combination is also desirable because, as disclosed by van Gilluwe, identifying the characteristics of the storage device enables one to determine whether it is even possible to install the operating system on the storage device.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-12, 14-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,681,323 to Fontanesi et al. (art of record, "Fontanesi") in view of U.S. Pat. No. 6,351,850 to van Gilluwe et al. (art of record, "van Gilluwe").

With respect to claim 1 (currently amended), Fontanesi discloses a method performed by a computer system (see, for example, the abstract) comprising:

(a) configuring a memory to store a control process (see, for example, column 4, lines 24-34, which shows configuring a memory of an installation server with programs and procedures to control installation, i.e. a control process).

Although Fontanesi discloses determining the size of a storage device (see, for example, column 6, lines 51-55), Fontanesi does not expressly disclose:

(b) in response to a size of a storage device, identifying a sector offset on the storage device.

However, Fontanesi further discloses partitioning a storage device (see, for example, column 6, lines 42-58), formatting the storage device (see, for example, column 6, line 59 to column 7, line 4), and storing and installing an image file on the storage device (see, for example, column 7, lines 5-25), among other operations. Inherently, Fontanesi must identify a location on the storage device with which to perform each of these operations. For example, Fontanesi cannot store an image file on the storage device, as disclosed, without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device.

Although the identified location on the storage device is not expressly a sector offset, van Gilluwe discloses identifying the number of sectors and the number and location of each

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partition on a storage device (see, for example, column 6, lines 17-34). The sectors are numbered based on a reference point (see, for example, column 2, lines 12-15), which is to say that the sector numbers are offsets from the reference point. Van Gilluwe further discloses that the sector numbers, or in other words, the sector offsets, identify unique locations on the storage device (see, for example, column 2, lines 15-25). Moreover, van Gilluwe expressly discloses determining the size of each partition and the amount of free space in each partition when identifying the location of a partition (see, for example, column 6, lines 17-34). Thus, van Gilluwe teaches identifying a sector offset of a partition in response to a size of the storage device, such as the size of each partition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Fontanesi with the features taught by van Gilluwe so that the location at which to store an image file, for example, can be identified based on the characteristics of the storage device. Fontanesi and van Gilluwe are both directed toward the installation of an operating system (see, for example, the abstracts). Accordingly, the combination of Fontanesi and van Gilluwe is also desirable because, as disclosed by van Gilluwe, identifying the characteristics of the storage device enables one to determine whether it is even possible to install the operating system on the storage device (see, for example, column 6, lines 35-49).

Therefore, Fontanesi in view of van Gilluwe teaches, in response to a size of a storage device, identifying a sector offset on the storage device.

Fontanesi in view of van Gilluwe further discloses:

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(c) determining the sector offset by the control process prior to an operating system being installed on the computer system (see, for example, Fontanesi, column 5, lines 20-24, which shows that an operating system is not installed on the computer system);

(d) storing an image onto the storage device at the sector offset by copying the image from the memory to the storage device (see, for example, Fontanesi, column 7, lines 5-25, which shows copying and storing an image file onto the storage device from the memory of the installation server, and column 4, lines 1-23, which further shows that the image includes an operating system).

Note that as presented above, Fontanesi cannot store an image file on the storage device without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device, and subsequently storing an image onto the storage device at the identified location. In view of van Gilluwe, the location is identified in terms of a sector offset.

(e) providing the sector offset to an installation engine (see, for example, Fontanesi, column 5, lines 25-38, which shows a boot storage medium for installing the operating system, i.e. an installation engine).

Again, the location on the storage device, identified in terms of a sector offset, is inherently provided to the installation engine so that it can operate.

(f) subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image (see, for example, Fontanesi, column 7, lines 5-25, which shows installing and configuring the operating system from the image file subsequent to copying and storing the image onto the storage device).

With respect to claim 2 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, partitioning the storage device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, lines 42-58, which shows subsequently partitioning the storage device).

With respect to claim 3 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, performing a formatting operation on the storage device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, line 59 to column 7, line 4, which shows subsequently formatting the storage device).

With respect to claim 5 (original), Fontanesi in view of van Gilluwe further discloses identifying the sector offset in response to a size of the image (see, for example, van Gilluwe, column 6, lines 35-49, which shows determining whether the operating system can be installed based on the size of the operating system).

With respect to claim 6 (original), Fontanesi in view of van Gilluwe further discloses providing the sector offset to the installation engine by storing the sector offset in a predetermined location on the storage device (see, for example, van Gilluwe, column 6, lines 17-34, which shows that the characteristics of the storage device are stored on the storage device, i.e. at a predetermined location, and Fontanesi, column 5, lines 53-61, which further shows storing a value at a predetermined location on the storage device).



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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or the sector offset to the installation engine by storing it in a predetermined location on the storage device, so that the sector offset can be maintained even in the event of a reboot (see, for example, Fontanesi, column 5, lines 53-61) or a power failure (see, for example, van Gilluwe, column 8, lines 21-32).

With respect to claim 7 (original), although Fontanesi discloses program logic, i.e. procedures and functions, for installing the operating system on the storage device (see, for example, column 5, lines 39-50), Fontanesi in view of van Gilluwe does not expressly disclose providing the sector offset to the installation engine by passing the sector offset as part of a function call to initiate the installation engine.

However, passing a parameter as part of a function call is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or sector offset to the installation engine by passing it as part of a function call, as is known in the art.

With respect to claim 8 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image from a CD-ROM (see, for example, Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from a CD-ROM).

With respect to claim 9 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image over a network (see, for example,

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Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from the installation server over a LAN).

With respect to claim 10 (currently amended) and claims 11, 12 and 15-18 (original), the claims recite a computer program product that corresponds to the method recited in claims 1-3 and 5-9, respectively (see the rejections of claims 1-3 and 5-9 above). Note that Fontanesi further discloses a computer program product comprising a computer program processable by a computer system and an apparatus from which the computer program is accessible by the computer system (see, for example, column 5, lines 25-50 and column 8, lines 12-15).

With respect to claim 19 (currently amended) and claims 20, 21 and 23-27 (original), the claims recite a system that corresponds to the method recited in claims 1-3 and 5-9, respectively (see the rejections of claims 1-3 and 5-9 above). Note that Fontanesi further discloses a system comprising a computer system (see, for example, FIG. 1).

With respect to claim 28 (currently amended), the limitations recited in the claim are analogous to those of claims 1, 3, 6 and 9 (see the rejections of claims 1, 3, 6 and 9 above).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall  
Examiner  
Art Unit 2192

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**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**